

Remarks

The Applicants would like to thank the Examiner for his thorough attention to the present matter. In response to the Examiner's Office Action, independent claims 1, 12, 18 and 19 have been amended to more particularly point out and distinctly claim that which the Applicants regard as their invention. 35 U.S.C. §112, ¶2. These claims have been amended to more distinctly recite concrete and tangible technological functions performed by computer-implemented operations of the Applicants' invention. As the Examiner recognized, such operations "being performed by a computer within a computer" constitute statutory subject matter under 35 U.S.C. §101. *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). (Paper No. 2, p.4.)

The Applicants respectfully contend that independent claims 1, 12, 18 and 19, as amended, are not taught or suggested by the prior art. The Examiner rejected original claims 1, 2, 4-6, 12, 13, 15, 16, 18-20 under 35 U.S.C. §103(a) as being unpatentable over Kirke, *Employees snapping up array of volunteer benefits*. However, Kirke makes no mention or suggestion of using a computer system to automate the provision of automobile concierge services, as the amended claims more particularly recite. Accordingly, the Examiner cannot establish *prima-facie* obviousness. (MPEP 2143.03)

The Examiner's rejection of original claims 5, 12, 13, 15, 16, 19 and 20 was based entirely on the level of skill in the art. However, MPEP 2143.01 expressly prohibits such a rejection:

**FACT THAT THE CLAIMED INVENTION IS WITHIN
THE ABILITIES OF ONE OF ORDINARY SKILL IN THE
ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS**

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not

sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). *See also In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

The Examiner rejected claim 14 under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Kuoch (Automatically schedule your car maintenance). However, the Kuoch reference teaches away from the "automobile concierge" aspect of the Applicants' claimed invention. Accordingly, the Examiner's rejection of claim 14 is improper. (MPEP 2141.02)

More specifically, Kuoch teaches a computer program, AutoTRACKER v1.0, that enables a user to automatically schedule car maintenance on his or her own. Using such a computer program, however, requires that the user have the resources, ability, and desire to install, configure and run such a program. The Applicants' claimed invention, on the other hand, involves a "concierge" service which eliminates such burdens on the car owner. Further, the ability to do such scheduling by one's self defeats the goal of the Applicants' claimed invention: to establish a "business relationship." No relationship would be established with a do-it-yourself program such as AutoTRACKER v1.0. Accordingly, one of ordinary skill in the art at the time the Applicants' invention was made would not have been motivated to combine Kirke and Kuoch in the manner proposed by the Examiner. Further, MPEP 2143.01 and MPEP 2143.02 prohibit the modification of references in such a manner that

would (i) render the references unsatisfactory for their intended purpose, (ii) change the principle of their operation, or (iii) lack a reasonable expectation of success.

Summary

Applicants have made a genuine effort to respond to the Examiner's rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

A fee for presentation of two additional dependent claims in the amount of \$36.00 is believed to be due as the result of the filing of this paper. Please apply this amount, as well as any additional fees or credits, to Deposit Account 06-1510 (Ford Global Technologies, Inc.). A duplicate of this paper is enclosed for that purpose.

The Examiner is requested to telephone the undersigned to discuss prompt resolution of any remaining issues necessary to place this case in condition for allowance.

Respectfully submitted,

DAVID WESTERMAN et al.

By


John S. Le Roy

Reg. No. 48,158

Attorney/Agent for Applicants

Date: July 7, 2004

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351